

REMARKS

The sole claim in this application remains unchanged herein.

Applicant notes and appreciates the fact that prosecution of this application has been reopened.

Claim 1 was rejected under § 102(b) over either

(1) Dutch PBR No. CHR3121, published June 16, 1999; OR

(2) Polish PBR Application No. OO 00739, published March 31, 2000;

in view of :

- (a) the admitted fact that the claimed cultivar was first sold in the Netherlands in January 1999; corroborated by Plant Varieties Journal, Vol. 17, no. 1, 2004; January (sic, Sept.) 15, 1999;

further in view of:

- (b) the Royal Horticultural Society [G.B.] Dictionary of Gardening, 1992, Vol. 1, allegedly describing how asexually to propagate a chrysanthemum.

The Office Action alleges that the cited publications, namely the Dutch PBR [application] CHR3121 as published 6/16/1999 [Exhibit A, attached], and the Polish PBR Application OO00739 as published 3/31/2000 [Exhibit B], “disclose the claimed variety.” But, in fact, those cited published PBR applications identify the claimed variety only by the breeder’s reference number, and did not disclose details about the claimed variety, namely the technical questionnaire portion of the PBR application, the “breeding history” of how the variety was

made, i.e., how it can be reproduced, and data learned in the official examination. See the May 3, 2003 letter from the Secretary-General of the Netherlands Board for Plant Breeders' Rights [Exhibit C], which examines Dutch applications for PBRs.

The cited Dutch PBR [Exhibit A] expressly states that its application number was CHR3121, and Applicant represents to the PTO that only Applicant's breeder's reference no. 98.4713 was used to identify the claimed variety in that application as initially published on June 6, 1999. Further, that Dutch PBR [Exhibit A] expressly shows that the denomination name of the claimed variety "Sunny Elite Reagan" was not even proposed to the Dutch authority until May 7, 2001, and PBR CHR3121 was not published disclosing that name of the claimed variety until June 16, 2001 (less than four weeks before the filing date of the instant U.S. plant patent application).

Likewise, the cited Polish PBR application [Exhibit B] used only Applicant's breeder's reference number 98.4713 to identify the claimed variety in that application as initially published March 31, 2000. And, that Polish PBR was not published disclosing the name of the claimed variety until June 30, 2001 (less than two weeks before the filing date of the instant U.S. plant patent application).

While the cited Dutch application and PBR [Exhibit A] and Polish application and PBR [Exhibit B] qualify as printed publications as of their respective publication dates, the published applications did not disclose the name of the claimed variety, and the PBRs disclosing that name were not published until June 2001. Even then, neither of those June 2001 publications alone was an enabling disclosure which alone put one of ordinary skill in this art in possession of the claimed variety. The Office Action, page 3, asserts that one of ordinary skill in this art would

have known where to obtain the claimed plant based upon the knowledge that such a skilled person would have from the aforementioned publications. However, before June 2001, the only identification that such a person would have had would have been the breeder's reference number. The published applications did not disclose what plant denomination to request until the PBRs were published in June 2001. That is, there is no information in the PBR applications as published linking the breeder's reference number in the PBR applications to the plants sold outside the United States under the name "Sunny Elite Reagan."

The cited January 1999 sales (outside the United States) of the claimed variety, were made under that plant's official name, Sunny Elite Reagan, not its breeder's reference number. The foreign sales alone are not de jure prior art, 35 U.S.C. § 102(b). No printed publication provided sufficient knowledge that it was disclosing "Sunny Elite Reagan" before June 2001. Thus, it could not have been before June 2001 that one of ordinary skill in this art could have had "knowledge" that the variety identified in the Dutch and Polish PBR applications was the "Sunny Elite Reagan" variety. Only as of June 2001 did the content elements of the Elsner theory co-exist, but time wise that was less than a month before the present Applicant's U.S. filing date, and thus ineffective as prior art as a matter of law. 35 U.S.C. § 102(b). And, Applicant still contends that Elsner was wrongly decided in direct conflict with the express language of § 102(b).

Applicant further notes that the facts of In re Elsner, 381 F.3d 1125 (Fed. Cir. 2004) were different from those of the instant case. Elsner's published European PBR application expressly named the plant in question with the "provisional denomination" PENDEC. 381 F.3d at 1127. Thus, in Elsner, the printed publication relied upon by the PTO and the Federal Circuit expressly


named the plant which was subsequently sold outside the United States. In the instant case, there is no evidence in the record that one of ordinary skill in this art had knowledge that linked the printed publications being relied upon by the PTO to the claimed variety sold outside the United States. Thus, here, there is no printed publication that is theoretically enabled by foreign sales of the claimed variety.

For all the foregoing reasons, the two printed publications cited as the bases of rejection in the Office Action do not sufficiently disclose the claimed variety to have enabled one of ordinary skill in the art to make and use the claimed variety more than one year before the filing date of the instant application. Accordingly, reconsideration and withdrawal of these grounds for rejection, and allowance of this application, are respectfully requested.

Respectfully submitted,

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